

REMARKS

This preliminary amendment is being submitted in conjunction with a "Utility Patent Application Transmittal" under to 37 C.F.R. 1.53(b) (hereafter the "Transmittal"). As noted in the Transmittal, the above-captioned application is a division of pending U.S. patent application Serial No. 10/255,450 filed September 26, 2002 (the "parent application"), which is a division of U.S. patent application Serial No. 09/599,213 filed June 22, 2000 (the "grandparent application"), now U.S. Patent No. 6,465,458 issued October 15, 2002. During prosecution of the '213 application, the U.S. Patent and Trademark Office issued an official action dated August 21, 2001, requiring the applicants "to elect a single disclosed species (i.e. a particular compound and a condition to be treated)." In response to the action, the applicants elected claims reciting an optically pure (S,S) reboxetine for the treatment of chronic pain. The present application includes claims (after entry of the amendments herein) reciting methods of treating an individual suffering from fibromyalgia and other somatoform disorders with racemic reboxetine. Accordingly, the methods recited herein by the amended claims do not read on the election made in the '213 application. It is submitted that no new matter is being introduced by the amendment.

The title of the application has been amended to be consistent with the claims. Furthermore, the specification has been amended to update the cross-reference to related applications.

Claims 1-40, 42, 43, 52, and 53 have been canceled, without prejudice.

Claim 41 has been amended to recite a method of treating fibromyalgia and other somatoform disorders, wherein the method comprises the step of administering a therapeutically effective dose of racemic reboxetine or a pharmaceutically acceptable salt thereof to an individual. Support for the amendment can be found in claim 41 of the parent and grandparent applications. Support for the amendment also can be found in the specification of the parent and grandparent applications at, for example, page 12, lines 14-26, and page 26, line 25 to page 27, line 12.

Accordingly, by virtue of this amendment, claims 41 and 44-51 are pending

CONCLUSION


Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is urged to contact the undersigned attorney.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

September 24, 2003

By:


Sandip H. Patel (Reg. No. 43,848)
Attorneys for Applicants
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300 TELEPHONE